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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,385	12/16/2003	Robert A. Cordery	F-688	5365

7590 03/21/2005

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EXAMINER
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WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/737,385

Applicant(s)

CORDERY ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-42, drawn to a method for facilitating a transaction between a first party and a second party using a trusted third party system, classified in class 705, subclass 78.
  - II. Claims 23 and 44, drawn to an anonymous user system, classified in class 705, subclass 74.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as selecting an artificial personality and conducting a communications session between said selected artificial personality and said user to begin to develop a record of shard information based on a unique relationship between said user and said artificial personality. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Charles Malandra (Reg. No. 31,038) on March 2, 2005 a provisional election was made with traverse to prosecute the invention of I, claims 1-42.

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Affirmation of this election must be made by applicant in replying to this Office action. Claims 43 and 44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Claims 1-42 have been examined.

### *Specification*

7. The disclosure is objected to because of the following informalities: typographical error, change “down loads” to “downloads” (see paragraph [0063], line 5).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 38 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. Claim 38 recites the limitation "said information" in line 6. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 42 recites the limitations "said first party's" and "said second party" in lines 3 and 5 respectively. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1,2, 9, 10-13, 26, 30, 31 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by US Publication No. 2001/0039535 to Tsiounis et al.

Tsiounis et al. disclose a remotely located system, which is controlled by a trusted third party, receives said first party's (i.e. customer) instructions for fulfilling at least a part of said first party's obligations in said transaction (see paragraph [0036], lines 4-12), said trusted third party system communicating with said second party in a manner which provides said second party with perceptible assurance that said second party is in communication with said trusted third party system and transmitting information to said second party to provide assurance that said first party's instructions have been or will be fulfilled; whereby trust in said third party is transferred to said second party and said second party can trust that said first party's obligations have been or will be fulfilled (see paragraphs [0044], [0052], lines 12-23).

Referring to claim 2, Tsiounis et al. disclose the method where said first party transmits said instructions to said trusted third party system through a portable communications device which is one of a plurality of essentially functionally identical communications devices, whereby said first party can use any of said plurality of devices to transmit said instructions (see paragraphs [0098] and [0101]).

Referring to claim 9, Tsiounis et al. disclose said shared information is modified and structured by an artificial personality program (PAN calculator), whereby characteristics of the transmitted information produced by said program provide said second party with said perceptible assurance that said second party is in communication with said trusted third party system (see paragraphs [0044], [0048], [0052], lines 12-23).

Referring to claims 10 and 30, Tsiounis et al. disclose said first party's obligations in said transaction include payment to said second party (see paragraph [0036], lines 4-9).

Referring to claims 11-13 and 31, Tsiounis et al. disclose said first party transmits instructions to said trusted third party system to make said payment from a first party account, where said instruction include instructions to select said first party account from a plurality of accounts and where said plurality of accounts includes at least one of an account maintained with said trusted third party a bank account, a credit card account, or an account with a payment service (see paragraph [0042]).

Referring to claim 26, Tsiounis et al. disclose receive said first party's (i.e. customer) instructions for fulfilling at least a part of said first party's obligations in said transaction (see paragraph [0036], lines 4-12), communicate with said second party in a manner which provides said second party with perceptible assurance that said second party is in communication with

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said trusted third party system and transmit information to said second party to provide assurance that said first party's instructions have been or will be fulfilled; whereby trust in said third party is transferred to said second party and said second party can trust that said first party's obligations have been or will be fulfilled (see paragraphs [0044], [0052], lines 12-23).

Referring to claim 27, Tsiounis et al. disclose the system where said first party transmits said instructions to said trusted third party system through a portable communications device which is one of a plurality of essentially functionally identical communications devices, whereby said first party can use any of said plurality of devices to transmit said instructions, and said system is further programmed to test each input received to determine if said inputs are received from an authorized and uncorrupted one of said devices (see paragraphs [0098] & [101]).

Referring to claim 42, Referring to claim 26, Tsiounis et al. disclose receive said first party's (i.e. customer) instructions for fulfilling at least a part of said first party's obligations in a transaction (see paragraph [0036], lines 4-12), communicate with said second party in a manner which provides said second party with perceptible assurance that said second party is in communication with said trusted third party system and transmit information to said second party to provide assurance that said first party's instructions have been or will be fulfilled (see paragraphs [0044], [0052], lines 12-23).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al. as applied to claim 2 above.

Tsiounis et al. disclose said trusted third party system transmits said information to said second party through a communications device (see paragraph [0105], lines 1-5). Tsiounis et al. states that the embodiments of “the present invention may be conveniently implemented using conventional general purpose digital computers programmed according to the teachings of the present specification”. The examiner therefore interprets the portable communication device as a “conventional general purpose digital computer”. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to explicitly include the portable communication device for data transmission between the trusted third party and the second party. One of ordinary skill in the art would have been motivated to do this because it provides a convenient communication process.

Referring to claim 4, Tsiounis et al. disclose the method where said plurality of devices all have perceptible features which are difficult to reproduce, and are all tamper resistant to provide said perceptible assurance, whereby said second party perceptible assurance that said portable communications device is an authorized device and that said information provided by said trusted third party system is authentic (see paragraph [0092]). Notice, Tsiounis et al. teach the PAN server detecting a client hardware/software and deciding whether to use a client-based HSM such as a smart card for payment, which implies that a smart card or any other similar device may be used as the consumer's communication device. Also, it is known in the art that smart cards are tamper-resistant deices with “perceptible features”. One of ordinary skill in the



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art would have been motivated to do this because it minimizes potential security problems, which could occur from using a mobile terminal.

Referring to claim 5, Tsiounis et al. disclose perceptible features of a portable communications device (see claim 4 above). Tsiounis et al. do not expressly disclose the device include at least one of special materials used in its construction, patterns etched or otherwise affixed to its surface, fibers or particles embedded in its surface, holograms, or a unique form. However, this difference is only found in the nonfunctional descriptive material and is not functionally in the step recited. The transmitting information to said second party step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit information to a second party including any type of data/features because the subjective interpretation of the data/feature does not patentably distinguish the claimed invention.

As for claim 6, see claim 5's rationale above.

16. Claims 7, 8, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al. as applied to claims 6 and 26 above, and further in view of US Patent No. 6363357 to Rosenberg et al.

Tsiounis et al. disclose a trusted third party and second party exchanging information (see claim 6 above). Tsiounis et al. do not expressly disclose said shared information is based upon a pattern of information exchanged by said trusted third party system and said second party during

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the development of a relationship. Rosenberg et al. disclose shared information is based upon a pattern of information exchanged by said trusted third party system and said second party during the development of a relationship (see col. 4, lines 27-54). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the method wherein shared information is based upon a pattern of information exchanged by said trusted third party system and said second party during the development of a relationship. One of ordinary skill in the art would have been motivated to do this because it provides additional assurance of the party's identity.

Referring to claim 7, Tsiounis et al. disclose said shared information is modified and structured by an artificial personality program (PAN calculator), whereby characteristics of the transmitted information produced by said program provide said second party with said perceptible assurance that said second party is in communication with said trusted third party system (see paragraphs [0044], [0048], [0052], lines 12-23).

Referring to claim 29, Tsiounis et al. disclose said shared information is modified and structured by an artificial personality program (PAN calculator), whereby characteristics of the transmitted information produced by said program provide said second party with said perceptible assurance that said second party is in communication with said trusted third party system (see paragraphs [0044], [0048], [0052], lines 12-23).

17. Claims 14,15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al. as applied to claims 10 and 26 above, and further in view of US Patent No. 6363357 to Rosenberg et al.

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Tsiounis et al. disclose a second party and third party exchanging information (see claim 10 above). Tsiounis et al. do not expressly disclose the step of said second party providing instructions to said third party directing how said payment is to be made. Rosenberg et al. disclose the step of said second party providing instructions to said third party directing how said payment is to be made (see col. 4, lines 27-34). Notice, Rosenberg et al. teach the merchant sending the name of his bank during the registration phrase, the examiner interprets this process as directing the third party how the payments are to be made. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step of said second party providing instructions to said third party directing how said payment is to be made. One of ordinary skill in the art would have been motivated to do this because it ensures that the second party receives payment for the services provided.

Referring to claim 15, Tsiounis et al. disclose a second party (see claim 10 above). Tsiounis et al. do not expressly disclose said second party can provide instructions that said payment be made to an account maintained with said trusted third party. Rosenberg et al. disclose the second party providing instructions regarding payment to a third party (see col. 4, lines 27-34). Therefore, the examiner notes that the second party of Rosenberg is capable of providing instructions and **can provide** instructions that said payment are made to an account maintained with said trusted third party. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step where said second party can provide instructions that said payment be made to an account maintained with said trusted third party. One of ordinary skill in the art would have

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been motivated to do this because it ensures that the second party receives payment for the services provided.

18. Claims 16-25, 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al. as applied to claim 1 above, and further in view of US Patent No. 6363357 to Rosenberg et al.

Referring to claims 16,20, and 33, Tsiounis et al. disclose a first party's obligation (see claim 1 above). Tsiounis et al. do not expressly disclose the first party's obligations in said transaction include providing a copy of a document to said second party. Rosenberg et al. disclose the first party's obligations in said transaction include providing a copy of a document to said second party where the document is an identification document (see col. 8, lines 26-32; col. 10, lines 54-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step where the obligation include providing a copy of a document to said second party. One of ordinary skill in the art would have been motivated to do this because effectively transmits data.

Referring to claims 17 and 34, Tsiounis et al. disclose a trusted third party system and a second party exchanging information (see claim 1 above). Tsiounis et al. do not expressly disclose said document has been previously stored with said trusted third party system and said trusted third party system transmits said document to said second party. Rosenberg et al. disclose said document has been previously stored with said trusted third party system and said trusted third party system transmits said document to said second party (see col. 9, lines 28-32). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step where said document

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has been previously stored with said trusted third party system and said trusted third party system transmits said document to said second party. One of ordinary skill in the art would have been motivated to do this because it provides additional assurance of the party's identity.

Referring to claims 18,19 and 35, Tsiounis et al. disclose a trusted third party system and a first party (See claim 1 above). Tsiounis et al. do not expressly disclose the trusted third party system digitally signs said document on behalf of said first party. Rosenberg et al. disclose the trusted third party system digitally signs said document on behalf of said first party (see col. 8, lines 3 &4), where the document is one of a receipt, an offer, an acceptance, or a check (see col. 8, lines 26-32). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step where the trusted third party system digitally signs said document on behalf of said first party. One of ordinary skill in the art would have been motivated to do this because it secures the transmitted document.

Referring to claims 21, 22, 36 and 37, Tsiounis et al. disclose a first party, second party and trusted third party. Tsiounis et al. do not expressly disclose the step where said second party providing instructions to said third party directing how said document is to be delivered or where said first party transmits instructions to said trusted third party system, said instructions at least partly specifying the contents of said document. Rosenberg et al. disclose the step where said second party providing instructions to said third party directing how said document is to be delivered and where said first party transmits instructions to said trusted third party system, said instructions at least partly specifying the contents of said document (see col. 10, lines 54-67; col. 8, lines 26-32). At the time the invention was made, it would have been obvious to a person of

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ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the method where second party providing instructions to said third party directing how said document is to be delivered and where said first party transmits instructions to said trusted third party system, said instructions at least partly specifying the contents of said document. One of ordinary skill in the art would have been motivated to do this because effectively transmits data.

Referring to claim 23, Tsiounis et al. disclose the method where a party maintains an account with a trusted third party (see paragraph [0039]). Tsiounis et al. do not expressly disclose said party can access said trusted third party system to review said account. Rosenberg et al. disclose said party can access said trusted third part system to review said account (see col. 9, lines 28-34). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the step where said party can access said trusted third party system to review said account. One of ordinary skill in the art would have been motivated to do this because it allow parties to effectively track transactions.

Referring to claim 24, Tsiounis et al. disclose the method where said second party is a vendor and said transaction is a purchase by said first party from said second party (see paragraph [0036], lines 4-12). Tsiounis et al. do not expressly disclose the second party established a relationship with said trusted third party. Rosenberg et al. disclose the second party establishing a relationship with the trusted third party (see col. 4, lines 27-54). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Tsiounis et al. to include the method wherein the second party establishes

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a relationship with the trusted third party. One of ordinary skill in the art would have been motivated to do this because it provides additional assurance of the party's identity.

19. Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsiounis et al.

Tsiounis et al. disclose a portable communications device which is one of a plurality of essentially functionally identical communications devices for communicating with a trusted third party system (see paragraphs [0098] & [0101]). Also, Tsiounis et al. disclose the method where said plurality of devices all have perceptible features which are difficult to reproduce, and are all tamper resistant to provide said perceptible assurance, whereby said second party perceptible assurance that said portable communications device is an authorized device and that said information provided by said trusted third party system is authentic (see paragraph [0092]).

Notice, Tsiounis et al. teach the PAN server detecting a client hardware/software and deciding whether to use a client-based HSM such as a smart card for payment, which implies that a smart card or any other similar device may be used as the consumer's communication device. It is known in the art that smart cards are tamper-resistant devices with "perceptible features". One of ordinary skill in the art would have been motivated to do this because it minimizes potential security problems, which could occur from using a mobile terminal.

Referring to claim 39, Tsiounis et al. disclose perceptible features of a portable communications device (see claim 4 above). Tsiounis et al. do not expressly disclose the device include at least one of special materials used in its construction, patterns etched or otherwise affixed to its surface, fibers or particles embedded in its surface, holograms, or a unique form. However, this difference is only found in the nonfunctional descriptive material and is not

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functionally in the step recited. The transmitting information to said second party step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit information to a second party including any type of data/features because the subjective interpretation of the data/feature does not patentably distinguish the claimed invention.

As for claim 40, see claim 39's rationale above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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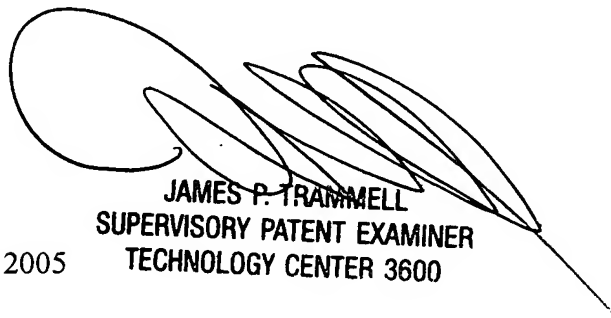
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**JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**



**Jalatee Worjloh  
Patent Examiner  
Art Unit 3621**

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March 7, 2005